

Serial No. 10/049,208
A0000135-01-CFP

REMARKS

I. Status of the Application

This paper responds to a Non-Final Office Action. The present application is a U.S. national filing of a PCT application. The PCT application was filed with 18 claims, which prior to entry in the U.S., were amended under Article 19 of the PCT, resulting in claims 1-17. This paper cancels claims 1-17, without prejudice or disclaimer, and adds new claims 18-37. Accordingly, claims 18-37 are under currently under consideration. Applicant respectfully requests reconsideration of the pending claims. By action taken here, Applicant in no way intends to surrender any range of equivalents beyond that needed to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves all such equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

II. Petition for Two-Month Extension of Time

This paper responds to a Non-Final Office Action, which was mailed on June 13, 2003. The Non-Final Office Action set a shortened statutory period for reply of three-months from the mailing date of the Office Action, making any response due on or before September 13, 2003. Applicant is filing this paper on November 13, 2003, which is within the second month following expiration of the shortened statutory period for reply. Applicant therefore petitions for a two-month extension of time and encloses the requisite fee under 35 CFR 1.17(a)(1).

III. New Claims 18-35

Applicant has replaced claims 1-17 with new claims 18-37. New claim 18 is similar to claim 1, but also requires that the inert solvent be aromatic, that the organic compound being oxidized has at least one nitrogen atom, sulfur atom, hydroxy group, or carbon-carbon double bond, and that the metalloporphyrin has a structure represented by formula 1. Dependent claims 19-35 are similar to claims 2-17, and in some cases, have been amended to improve readability. Claims 36 and 37 recite specific electron-withdrawing groups for substituents R1-R11. The

(Amendment—page 6 of 9)

Serial No. 10/049,208

A0000135-01-CFP

amendments are fully supported in the specification as filed (see, e.g., pages 2-7 of the application). Therefore, Applicant submits that none of the amendments introduce new matter.

IV. Abstract

Applicant has amended the abstract to better describe the disclosure.

V. Rejection of Claims 1-17 Under 35 U.S.C. § 112, First Paragraph

The present Office action rejected claims 1-17 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. According to the Office action, the use of a proviso recited in claim 1 was not present when the case was filed originally. The Office action also rejected claims 1-17 because the "specification, while being enabling for the oxidation of diazepam (see example 2, compound 1), does not reasonably provide enablement for the oxidation of any organic compound." Applicant respectfully traverses these rejections.

Applicant submits that the rejection based on the proviso does not apply to claims 18-37 since they do not recite the proviso. Additionally, Applicant submits that the enablement rejection does not apply to claims 18-37 because they require that the organic compound recited in claim 18 has "at least one nitrogen atom, sulfur atom, hydroxy group, or carbon-carbon double bond." Furthermore, Applicant has recited a metalloporphyrin given by formula 1. Applicant notes that the specification at page 2, line 27 through page 3, line 12, discloses characteristics of the organic compound that are recited in claim 18, and the specification at page 3, line 20 through page 4, line 9, describes suitable metalloporphyrin catalysts. These characteristics of the organic compound and the description of suitable metalloporphyrins would enable a person of ordinary skill in the art to carryout the claimed invention.

Furthermore, Applicant respectfully disagrees with the Office action's characterization of Example 1. Contrary to the comments in the Office action, Applicant submits that each of the products described in Example 1 (compounds 2-6) are oxidation products since the proportion of electronegative substituents in each of them has increased relative to compound 1. Moreover, the large number of products obtained in Example 1 (compounds 2-6) is a desirable and advantageous feature of the claimed invention. As noted in the Summary of the Invention:

(Amendment—page 7 of 9)

Serial No. 10/049,208
A0000135-01-CFP

The process of the invention is extremely useful in pharmaceutical research and development as it can be used to perform preliminary evaluations of the metabolic processes which are likely to occur when a given compound is tested in vivo. . . . In other words, the process of the present invention opens the possibility of obtaining and analyzing in a more systematic fashion a higher number of individual potential metabolites for a given selected compound on which the process is carried out.

In other words, the examples do not indicate that the "reaction is not clean," but instead demonstrate that the claimed invention unexpectedly produces a larger number of potential metabolites, in higher yield, than any comparable system.

Applicant respectfully requests withdrawal of the rejection of claims 1-17, as now applied to new claims 18-37.

VI. Rejection of Claims 1-17 Under 35 U.S.C. § 112, Second Paragraph

The present Office action rejected claims 1-17 under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Office action contends that the phrase "organic compounds" and the term "metalloporphyrin" are indefinite. Applicant respectfully traverses these rejections.

Applicant respectfully submits that a person of ordinary skill in the art would understand what is meant by the phrase "organic compounds" and by the term "metalloporphyrin," and therefore Applicant contends that the rejection of claims 1-17 under 35 U.S.C. § 112, second paragraph is improper. Furthermore, the rejection should not apply to claims 18-37 because, as noted above, these claims require that the organic compound recited in claim 18 has "at least one nitrogen atom, sulfur atom, hydroxy group, or carbon-carbon double bond," and such characteristics would permit a person of ordinary skill in the art to understand which organic compounds fall within the scope of the claims. Similarly, Applicant has recited a metalloporphyrin given by formula 1, which would also permit a person of ordinary skill in the art to know which metalloporphyrins fall within the scope of claims 18-37.

Applicant respectfully requests withdrawal of the rejection of claims 1-17, as now applied to new claims 18-37.

(Amendment—page 8 of 9)

Serial No. 10/049,208
A0000135-01-CFP

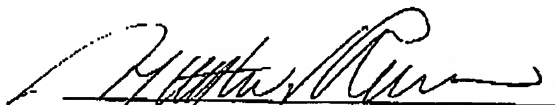
VII. Conclusion

In view of the foregoing, Applicant respectfully submits that all pending claims are patentable. If the Examiner has any questions, Applicant requests that the Examiner telephone the undersigned.

Applicant believes that any fees required to file the present amendment have been identified in a fee transmittal that accompanies this paper. However, if any fees are required in connection with the filing of this paper have not been identified in the accompanying transmittal, please charge deposit account number 23-0455.

Respectfully submitted,

Date: November 13, 2003



Matthew J. Russo
Registration No. 41,282
Warner-Lambert Company LLC
2800 Plymouth Road
Ann Arbor, MI 48105
Tel: (734) 622-1747
Fax: (734) 622-1553
Customer No. 28880

(Amendment—page 9 of 9)